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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2164

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/650,362	BENNETT ET AL.	
	Examiner	Art Unit	
	Leslie Wong	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12,14-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 28 February 2006, is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-12, 14-23, and 25-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 1, 12, and 23 recite "allowing a user in communication with the visual browser to **non-explicitly select a main product**". This limitation appears to be conflicting with the Applicant's disclosure because the Specification states that the user has to pick a main product (i.e., explicit) before the browser can automatically presents related products.

Applicant's Response filed 23 February 2006 states:

Applicant has amended these claims to further clarify the embodiments of the invention. As set forth in Applicant's patent application on pages 11-12: "The visual browser of the present invention allows a user to navigate a virtual store hosted by an ISP, *without needing to express verbally what they are looking for (i.e. an explicit method), and instead provides non-explicit methods for virtual shopping*...In particular, after a user picks a main product, the visual browser automatically presents similar and related products, and also possibly non-related products, to the user providing opportunities for the user to view and possibly purchase these other related and non-related products." (Emphasis added).

Applicant's Specification page 11, lines 20-23 discloses:

The visual browser of the present invention allows a user to navigate a virtual store hosted by an ISP, without needing to express verbally what they are looking for (i.e. an explicit method), and instead provides non-explicit methods for virtual shopping. In particular, after a user picks a main product, the visual browser automatically presents similar and related products,

Further, Applicant's Specification page 14, lines 10-20 discloses:

Figure 3A is an example of a user interface 300 at a user's terminal computer displaying a main product and related products according to one embodiment of the invention. When a user logs on to a service provider having the visual browser of the present invention to engage in virtual shopping at the service provider's virtual store, the user is presented on the display of his/her computer with a user interface similar to that the Figure 3A. Of course the types of products shown, depend upon the type of virtual store and the products carried by that virtual store. Utilizing the visual browser of the present invention, when a user first enters the virtual store a random selection of items from the service provider's database of products is displayed as in Figure 3A. In this instance, a Deluxe Italian Basket 301 is randomly selected as the main product and is displayed in the main product space 302. Underneath the main product is a description of the main product and a price for the main product.

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Based on the above, it appears that Applicant's invention does not enable (i.e., teach how to) the step of "non-explicitly" select a **main** product. Since "a user picks a main product" appears to be an explicit step, the claimed limitation "allowing a user in communication with the visual browser to **non-explicitly select a main product**" is inconsistent with Applicants' disclosure.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1, 3-12, 14-23, and 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 12, and 23 recites "allowing a user in communication with the visual browser to **non-explicitly select a main product**".

Applicant's Specification, page 11, lines 20-23, discloses the term "non-explicitly" is without needing to express verbally what they are looking for. Applicant's Response page 12, paragraph 4, states that "Currently, most e-commerce virtual shopping experiences rely on users explicitly knowing what they are looking for and describing it in verbal ways (i.e., an explicitly method)...For example, most virtual shopping through today's e-commerce websites requires a user to search for products by inputting verbal terms, going down through a multitude of different categories, ... or selecting various product attributes stored in a database to finally find a desired product." It is not

understood how the user can pick a **main** product without indicating or expressing or selecting what his/her desired product.

Claims 3-11, 14-22, and 25-33 are rejected for fully incorporating the deficiencies of their respective base claims by dependency.

Examiner's Remarks

7. For purpose of examination, Examiner interprets the limitation "allowing a user in communication with the visual browser to non-explicitly select a main product" as the user has to click on/select the item in order to select the MAIN product.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12 and 14-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

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Claims 12 and 14-22 appear to be non-statutory because the "machine-readable medium" as used herein can take the form of signal/carrier waves. Applicants' Specification, page 25, line 22 – page 26, line 10, discloses "...machine-readable medium transmitted by data signal embodied a carrier wave..."

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

See Interim Guidelines page 55, section (c) **Electro-Magnetic Signals**.

Applicants are suggested to amend the term "machine-readable medium" to "machine-readable **storage** medium" to include only volatile and non-volatile mediums in order to overcome the above 101 rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 3-12, 14-23, and 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jacobi et al.** ("Jacobi") (U.S. Patent 6,317,722 B1) in view of **Danish et al.** ("Danish") (U.S. Patent 6275821 B1)

Regarding claims 1, 12, and 23, **Jacobi** teaches a method and an apparatus comprising:

a). upon a user accessing a virtual store having a visual browser via a computer network, displaying a random assortment of products to the user associated with the virtual store (col. 5, lines 19-22 and 32-35);

b). creating a plurality of categories, each category identifying an attribute (col. 5, lines 32-35; col. 7, lines 5-7 and 14-17; col. 1, lines 16-22 and 46-49);

c). associating products (i.e. books, CDs, or videos) having at least one attribute with at least one category (i.e., non-fictions, comedies) (col. 2, lines 46-49);

d). allowing a user in communication with the visual browser to non-explicitly select a main product (col. 5, lines 32-35; col.7, lines 5-7; and); and

d). upon selection of a main product, automatically displaying a plurality of related products having at least one attribute in common with the main product that are selectable for purchase by the user (col. 3, lines 52-55; col. 10, lines 45 – 63; col. 7, lines 5-9; col. 4, lines 2-6; Fig. 2, element 94).

Jacobi does not explicitly teach displaying a random assortment of **graphical representations** of products.

Danish, however, teaches “displaying a random assortment of **graphical representations** of products” as a picture search provides to the user a display of a series of pictures, each picture representing either a family cluster or a family of items that are available to be searched (col. 6, lines 11-14 and Fig. 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of the cited references because **Danish's** teaching would have allowed **Jacobi's** to provide the user visual images of the desired products in an effort to facilitate making buying decisions by displaying a series of pictures representing the available items.

Regarding claims 3, 14, and 25, **Jacobi** further teaches a step comprising, displaying at least one other product that is not related by a category to the main product (col. 4, lines 2-6).

Regarding claims 4, 15, and 26, **Jacobi** further teaches a step comprising, assigning a weight bias to each category based upon a predefined importance of the respective category (col. 3, lines 23-27).

Regarding claims 5, 16, and 27, **Jacobi** further teaches a step comprising:

- a). determining "like" categories for the main product, a "like" category being a category that the main product is associated with (col. 8, lines 60-63);
- b). selecting one of the "like" categories (col. 10, line 63 – col. 11, line 2); and
- c). randomly selecting the at least one other related product from the selected "like" category (col. 5, lines 19-22).

Regarding claims 6, 17, and 28, **Jacobi** further teaches a step wherein selecting one of the "like" categories includes utilizing the weight biases for the categories in a randomly based selection algorithm to select one of the "like" categories (col. 8, lines 28-39).

Regarding claims 7, 18, and 29, **Jacobi** further teaches a step comprising:

- a). determining "dislike" categories for the main product, a "dislike" category being a category that the main product is not associated with (col. 15, lines 58-62);
- b). selecting one of the "dislike" categories utilizing the weight biases for the categories in a randomly based selection algorithm (col. 5, lines 19-31); and
- c). randomly selecting at least one other product from the selected "dislike"

category (col. 5, lines 19-31).

Regarding claims 8, 19, and 30, **Jacobi** further teaches a step comprising:

- a). selecting a category from the plurality of categories utilizing the weight biases of the categories in a randomly based selection algorithm (col. 14, lines 36-48); and
- b). randomly selecting a product from the selected category (col. 5, lines 19-22).

Regarding claims 9, 20, and 31, **Jacobi** further teaches a step comprising:

- a). scoring each product based upon weight biases of "like" categories (Fig. 5, element 180) and "dislike" categories (Fig. 5, element 190), a "like" category being a category that the main product is associated with, a "dislike" category being a category that the main product is not associated with, a weight bias being a predefined value assigned to each respective category to denote the respective category's importance (col. 8, lines 28-38);
- b). creating a "like" score table, the "like" score table including a "like" score for each of the products indicating the relatedness of the product to the main product (Fig. 1, element 60); and
- c). randomly selecting the at least one other related product from the "like" score table using the "like" scores as a weight bias (col. 12, lines 61-65).

Regarding claims 10, 21, and 32, **Jacobi** further teaches a step comprising:

- a). creating a "dislike" score table, the "dislike" score table including a "dislike" score for each product indicating the unrelatedness of the product to the main product, the "dislike" score table being the transposition of the "like score table" (col. 8, lines 28-39); and
- b). randomly selecting at least one other product from the "dislike" score table using the "dislike" scores as a weight bias (col. 5, lines 19-31).

Regarding claims 11, 22, and 33, **Jacobi** further teaches a step of selecting at least one other product at random from one of the plurality of categories (col. 5, lines 19-22).

Response to Arguments

11. Applicants' arguments filed 28 February 2006 have been fully considered but they are not persuasive.

Applicants argue that the examiner's citations for limitation "displaying a random assortment of products to a user" do not teach or suggest the claimed limitation. Instead, the citations only refer to an **Amazon.com web-site** that includes functionality for allowing users to search, browse, and make purchases from an on-line catalog... and that allows a user to create multiple shopping carts within a single account.

In response to the preceding arguments, Examiner respectfully submits that it would be apparent to the reader that **Jacobi's** teaching of providing functionality for

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allowing users to search, browse, and make purchases from an on-line catalog etc...

implies that upon users conducted a search to find the interested products, the system would display/list selected items as search results and allow users to pick the desired products and make purchases (i.e., add to shopping carts).

The below image from the Amazon.com shows a variety of products: Apparel and Accessories, Beauty, DVD's TV Central, Electronics, Gourmet Food, and Shoes etc... which Amazon offers from the website.



As can be seen from the above, Jacobi teaches the limitation "displaying a random assortment of products to a user" as claimed.

Applicants argue that Jacobi's methods are clearly explicit methods, and in fact teach away from Applicant's amended independent claims "... allowing a user in communication with the visual browser to non-explicitly select a main product".

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In response to the preceding arguments, Examiner respectfully submits that Applicant's Specification fails to teach how to non-explicitly select a main product. As a result, Examiner relies on Applicant's specification page 11, lines 20-23 and page 14, lines 10-20 which disclose that the user has to **pick a main product** to examine the claimed limitation. Similar to Jacobi's teaching, Applicant's invention also requires that the user has to pick a main product; therefore, it is submitted that Jacobi's teaching is consistent with Applicant's claimed invention. Hence, Jacobi teaches the limitation as claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Leslie Wong
Primary Patent Examiner
Art Unit 2164

LW
May 18, 2006